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In re Application of	:
David J. Yang et al	:
Serial No.: 09/599,152	: PETITION DECISION
Filed: June 21, 2000	:
Attorney Docket No.: UTXC:664	:

This is in response to the petition under 37 CFR 1.144, filed September 6, 2005, requesting withdrawal of an improper restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 on June 11, 2000, and contained claims 1-51. In a first Office action, mailed September 27, 2001, the examiner set forth a 4 way restriction requirement, summarized as follows:

Group I – Claims 1-32, drawn to a composition and kit comprising a radionucleotide, ethylene cysteine and a ligand;

Group II – Claims 33-41, drawn to a method of synthesizing ethylene dicysteine for imaging;

Group III – Claims 42-50, drawn to a reagent and kit comprising a ligand linked to a Tc-99 moiety;

Group VI – Claim drawn to a method of determining drug effectiveness on a tumor.

The examiner provided appropriate reasoning for restriction and further required an election of species within whichever group was elected..

Applicants replied on October 26, 2001, canceling claims 1 and 42-51 and amending claims 2-32. Applicants then elected the method of Group II and made all claims dependent on the Group II invention. No traversal of the requirement was made.

The examiner mailed a new Office action to applicants on April 24, 2002, acknowledging the election of Group II and the species and acted on all of the claims. Rejections under 35 U.S.C. 112, second paragraph, and under 35 U.S.C. 103(a) over various references were made.

Applicants replied on July 30, 2002, amending claims 9 and 22 and adding claims 52-55. The rejections were appropriately argued.

The examiner mailed a Final Office action to applicants on October 28, 2002, withdrawing the rejection under 35 U.S.C. 112, second paragraph, and some of the rejections under 35 U.S.C. 103(a). Claims 6-32, 39-41 and 52-55 were indicated as allowable if placed in independent form including all limitations of the claims from which they were dependent.

Applicants replied on January 7, 2003, canceling claim 33 and proposing amendments to claims 2-3, 5 and 34, and presenting arguments for patentability. Following an Advisory Action mailed January 29, 2003, RCE papers were filed on March 24, 2003, with an additional amendment and argument.

The examiner mailed a new non-Final Office action to applicants on September 29, 2003, withdrawing all previous rejections and setting forth a new rejection under 35 U.S.C. 112, first paragraph, for lack of enablement. The claims were also rejected under 35 U.S.C. 112, second paragraph, as indefinite. Claims 7, 11-14, 6(sic 16)-19, 21-22, 24-29 and 52-55 were objected to as allowable if rewritten in independent form including all limitations of the claims from which they depend.

Applicants replied on April 8, 2004 (COM dated March 29, 2004), amending claims 2, 7, 9, 20, 32 and 35 and adding claims 56-61. The rejections were argued in an appropriate manner.

The examiner mailed a Final Office action to applicants on June 25, 2004, setting a three month shortened statutory period for reply, withdrawing in part the rejections under 35 U.S.C. 112, first and second paragraphs, but maintaining other parts. Claims 7, 11-14, 16-22, 24-29 and 52-55 were indicated allowable if placed in independent form. Claims 56-61 were held non-elected as being directed to an invention independent and distinct from that elected.

Applicants replied on December 30, 2004 (COM dated December 23, 2004), by filing a Notice of Appeal and a reply to the Office action. The reply amended claims 7, 11, 16, 24, 52-53 and 55, and canceled claim 54. The reply addressed the rejections again and traversed the restriction requirement holding claims non-elected by original presentation.

The examiner mailed an Advisory Action to applicants on January 28, 2005, denying entry of the amendment and setting forth reasons therefore. Applicants then filed a second set of RCE papers on February 25, 2005, and requested that the amendment be entered.

The examiner then mailed a non-Final Office action to applicants on May 20, 2005, setting a three month shortened statutory period for reply. The examiner maintained the previously set forth rejections under 35 U.S.C. 112, first and second paragraph. The examiner also replied to the traversal of the restriction requirement and maintained it for the reasons set forth in the previous Office action. The requirement was not made Final.

This petition was filed on September 6, 2005, and traverses the maintaining of the restriction requirement as improper. Although the requirement was not made Final in the last Office action, the requirement was repeated by the examiner and is therefore ripe for supervisory review.

DISCUSSION

Applicants, as noted, did not traverse the original restriction requirement and proceeded with prosecution of the elected group, all claims being amended to fall within the group in response to the requirement. During prosecution claims have been added. The examiner had no objection to the addition of claims 52-55 and included them in further proceedings. The examiner, however, did object to the addition of claims 56-61, holding them to be non-elected by original prosecution.

Applicants argue that newly presented claim 56 is identical to claim 33 as originally set forth prior to restriction and was unamended prior to the first action on the merits. Claim 58 is identified as the same as claim 35 and claim 60 corresponds to original claim 38. A review of the claims shows applicants assertions to be correct. Claims 57, 59 and 61 depend from their immediately preceding claims and are thus more limited.

The only reason given by the examiner for holding claims 56-61 as non-elected is that they are broader than the claims previously examined (page 6, Office action dated 6/25/2004); specifically that they read on any and all tissue specific ligands. No additional explanation is given in the subsequent Office action in response to applicants traverse.

It is clear from the above review that the added claims are directed to the same invention as originally elected and currently under examination since they are identical to and no broader than original claims 33, 35 and 38 of elected Group II. That they may be broader than the amended claims examined in the last Office action is immaterial since they fall within the invention elected in response to the original restriction requirement. The claims have been improperly withdrawn from consideration.

DECISION

The petition is **GRANTED**.

The Office action of May 20, 2005, is withdrawn as incomplete. The application is returned to the examiner for preparation of a new Office action in which claims 56-61 are considered on their merits.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.



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